

AMENDMENT UNDER 37 C.F.R. § 1.111  
U.S. Appln. No. 10/051,015

**REMARKS**

Upon entry of this Amendment, claims 1-12 and 17-21 are all the claims pending in the application. Claims 13-16 are hereby canceled and claims 17-21 have been added. Applicant reserves the right to file canceled claims 13-16 in a further application.

Applicant wishes to thank the Examiner for acknowledging patentable subject matter in claims 2 and 3. The Detailed Action indicates that claims 1, 4-8, and 10-12 are rejected and claims 1-10 are objected to based on informalities, as noted in paragraphs 2-4 of the Office Action. Applicant notes, however, that the Office Action Summary indicates that claims 1, 4, 11 and 12 are rejected and claims 2, 3 and 5-10 are objected. For purposes of this response, Applicant assumes that the Detailed Action reflects the proper status of the claims, however, clarification is requested.

Also, since the Examiner has not set forth any explicit rejection or objection to claim 9, either in the Office Action Summary or in the Detailed Action, Applicant assumes that claim 9 recites patentable subject matter, that is, but for its current dependence on rejected claim 4. Applicant requests confirmation of the status of claim 9.

In regard to the claim rejections, claims 1, 11 and 12 are rejected under 35 U.S.C. §102(b) as being anticipated by JP 2000-163730 (JP '730). Claims 4 and 10 are rejected under 35 U.S.C. §102(a) as being anticipated by JP 2001-49007 (JP '007) and claims 5, 7 and 8 are rejected under 35 U.S.C. §103(a) as being unpatentable over JP 2001-49007 (JP '007). Finally, claim 6 is rejected under 35 U.S.C. §103(a) as being unpatentable over JP 2001-49007

(JP '007) in view of Goto et al. (USP 5,324,582). For the reasons described below, Applicant respectfully traverses the rejections.

## I. Claim Rejections under 35 U.S.C. §§ 102, 103 & Claim Objections

### *Summary*

Independent claim 1 defines a new and nonobvious magnetic transfer master medium having an uneven surface for transferring data to a slave medium. Further, the uneven surface contains depression portions which are partially open to adjacent protrusion portions. As described in detail below, at least this feature of the claimed invention is neither taught nor disclosed by JP '730. For at least this reason, the rejection of claim 1 should be withdrawn.

Claims 2 and 3 depend from patentable claim 1. Accordingly, for at least this reason, claims 2 and 3 are patentable over the cited prior art of record and the rejection thereto should be withdrawn.

For similar reasons to those discussed above in regard to independent claim 1, claim 4 also defines new and nonobvious patentable subject matter which is neither taught nor suggested by JP '007. In particular, JP '007 does not disclose or teach a magnetic transfer master medium having an uneven surface for transferring data to a slave medium. At least for this reason, the rejection to claim 4 should be withdrawn.

Claims 5-8 and 10 depend from patentable claim 4. For at least this reason, claims 5-10 are patentable over the cited prior art and the rejection thereto should be withdrawn. Additionally, the rejection of claim 6 should be withdrawn because Goto et al. does not

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compensate for the deficiencies of JP '007, discussed above, since it does not disclose a magnetic transfer master medium transferring data to a slave medium.

Regarding the objections to claims 1-10 based on informalities, Applicant has amended claims 1, 2, 4, 5-8 and 10-12 to change term "pattern" to "surface". With respect to the additional objection to claims 4-8, Applicant acknowledges that the Examiner's indicated interpretation of the specific claim language mentioned in the Office Action is correct.

***Argument***

With respect to the prior art rejections, Applicant respectfully submits that the Examiner has not met his burden of proof regarding the asserted anticipation and obviousness of the rejected claims because the cited prior art of record does not teach, suggest, or disclose a magnetic transfer master medium having an uneven surface for transferring data to a slave medium wherein the depression portions of the uneven surface are at least partially open to adjacent protrusion portions, as expressly required by the claims. The Examiner cites the translated abstract of JP '730 for the proposition that it teaches a magnetic transfer master medium containing an uneven surface for transferring data to a slave medium in which "[t]he depression portions are not completely surrounded by protrusions." (See paragraph 6 of the Office Action). However, JP '730 does not teach a magnetic transfer master medium transferring data to a slave medium. In fact, JP '730 only discloses a "magnetic recording medium." (See Translated Abstract, JP '730). Accordingly, the cited reference does not teach a magnetic transfer master medium and slave medium.

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The translated abstract of JP' 730 is also silent with respect to the claimed protrusions surrounding depression portions on less than all sides. Additionally, there is no disclosure in the translated abstract of JP' 730 that renders the features of claim 1 inherent. As a consequence, the Examiner has failed to establish that claim 1 is anticipated by JP '730. (See MPEP § 2131, “[a] claim is anticipated only if each and every element ... set forth in the claim is found, either expressly or inherently ... in a single prior art reference.”). For at least this reason, the rejection to claim 1 should be withdrawn.

For at least the same reason as discussed above, the rejection of claims 2-3 should be withdrawn as well since these claims depend from claim 1.

Similar to independent claim 1, claim 4 recites a magnetic transfer master medium having an uneven surface capable of transferring data to a slave medium. The Examiner refers to the translated abstract of JP '007 for teaching a magnetic transfer master medium with an uneven surface for transferring data to a slave medium. However, JP '007 merely discloses a “magnetic recording medium” with “big and rough protrusions.” (See Translated Abstract, JP '007). JP '007 does not teach, suggest, or otherwise disclose, a magnetic transfer master medium transferring data to a slave medium. For at least this reason, the rejection to claim 4 should be withdrawn.

In light of the reasoning mentioned above concerning claim 4, the rejection of claims 5-8 and 10 should also be withdrawn because these claims depend from claim 4.

In addition to its dependency from claim 4, claim 6 is patentable since it recites independently patentable subject matter. While the Examiner acknowledges that “JP '007 does

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not teach that the protrusions are coated with ... granular material,” the Examiner asserts that Goto discloses a magnetic transfer master medium having a granular material coated on the protrusion portions of an uneven surface. (See paragraph 12 of the Office Action where the Examiner cites Col. 5, lines 18-37 of Goto for this proposition). However, Goto fails to overcome the deficiencies of JP ‘007, discussed above. To be precise, the language in the cited portion of Goto merely provides that “silica grains ... having [a] uniform ... grain size” are formed on protrusions of a “magnetic recording medium [containing] a plurality of magnetic layers.” (Col. 5, lines 18-23; Col. 5, lines 40-43). Goto does not teach, or suggest a magnetic transfer master medium having an uneven surface coated with granular material on the protrusions. For this additional reason, the rejection of claim 6 should be withdrawn.

Additionally, we note that the Examiner objected to claims 1-10 and proposed that the term “pattern” be replaced with the term “surface.” Applicant has amended the claims as suggested to replace the term “pattern” with “surface.” Finally, the Examiner objected to claims 4-8 and alleged that it is unclear whether the “rough surface [is contained] on a magnetic transfer medium or [whether] the rough surface is present on the protrusions.” Nonetheless, the Examiner took the position that the protrusions were present on the rough surface. Applicant submits that this interpretation of claims 4-8 is correct. Thus, the objection should be withdrawn.

## II. New Claims

For additional claim coverage merited by the scope of the invention, Applicant has added claims 17-21. Applicant submits that none of the cited prior art references disclose, teach, or suggest the combination of features contained therein.

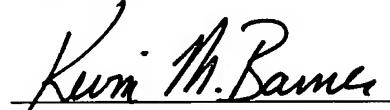
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**Conclusion**

In view of the foregoing remarks, the application is believed to be in form for immediate allowance with claims 1-12 and 17-21, and such action is hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, he is kindly requested to **contact the undersigned** at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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